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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,198	04/04/2005	Yoko Matsuzawa	040894-7204	9611
9629	7590	07/27/2006		
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER AUDET, MAURY A	
			ART UNIT 1654	PAPER NUMBER
DATE MAILED: 07/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/530,198

Applicant(s)

MATSUZAWA ET AL.

Examiner

Maury Audet

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1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-13 is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/03/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendment and arguments filed 05/03/2006 are acknowledged. Applicant's only substantive amendment is to claim 1 to now recite "and when R is a hydrogen atom, m is not 1", in order to overcome the recited prior art of record. This amendment has NOT been entered. Namely, the amendment is drawn to a new limitation which was not originally presented or searched. Therefore, a new search, beyond that originally conducted over the originally filed claims would be necessary in order to search the prior art for these new limitations. Thus, claims 1-3 are herein examined as originally presented.

Claim Rejections - 35 USC § 102

The rejection of claims 1-3 under 35 U.S.C. 102(e) as being anticipated by Hotta et al. (US 6,489,265 B1), is maintained for the reasons of record. Applicant's arguments (but not amendments, as indicated above) are not found persuasive. Since the amendment has not been considered, the only issue is Applicant's second argument that Hotta et al. does not disclose or suggest a fine spherical particle which has uniform molecular orientation. Since Hotta et al. teach the same compound formula, nothing would preclude the Hotta et al. compound from likewise having the same inherent functional attributes of being a fine spherical particle and having uniform molecular orientation. Applicant has not clearly delineated either by claim limitation or persuasive argument what 'other' structural features would somehow impute the former inherent functional attributes, to the same formula. Worded another way, Applicant has not persuasively argued (other than saying Hotta is silent about these inherent functional

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attributes), why the same formula in another reference would not itself contain the same functional attributes.

Again, Hotta et al. teach a fine spherical particle having uniform molecular orientation, which comprises a compound represented by formula (1), wherein R represents a hydrogen atom or an alkyl group having 1 to 5 carbon atoms; n is an integer of 8 to 20; and m is an integer of 1 to 3; evenly oriented in a radial pattern from the center; with a diameter from 0.01 to 100 micrometers (see col. 12, lines 36-41 and col. 13, lines 18-21 (teaching that a prepared organic low-molecular-weight material may consist of two or more compounds of compound A); Table 1 Compounds A #'s 1-10; Synthesis Ex.'s 1 and 2 of Compounds A (e.g. formula (1) species); col. 22, lines 36-41 and lines 61-64 and col. 23, lines 17-22 (teaching that the organic material may be fine particles (and as noted before, which consist of 2 or more Compounds A alone), which are spherical); and col. 23, lines 13-16 (teaching the particles are 20 or less micrometers in size)).

Therefore, the reference is deemed to anticipate the instant claims above.

Allowable Subject Matter

Claims 4-13, as drawn to a process for producing the fine spherical particle comprising the compound of formula (1) comprising immersing a substrate having hydrophilicity in an aqueous solution of a salt of the compound of formula (1); a spherical microcapsule comprising a hydrophilic core substance encapsulated inside the fine spherical particle of formula (1), and process for producing the latter, respectively, are not reasonably taught or suggested by the prior art of record. Thus, Applicant's method of preparing either of the above, whereby the compound(s) become insoluble under a weak acid thereby precipitating onto the hydrophilicity

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bearing/treated substrate (see Applicant's specification page 9, lines 10-15), was not reasonably taught or suggested by the prior art of record.

The closest prior art of record appears to be Hotta et al. Hotta et al. teach the use of a salt (sodium hydroxide) to prepare the fine spherical particle comprising the compound of formula (1), but does not expressly or reasonably provide motivation for a method of producing the above using a substrate having hydrophilicity, wherein the particle is precipitates onto the substrate, followed by extraction therefrom (Applicant's claims 4-7).

In addition, the prior art of record was found to teach general methods of making encapsulated microcapsules (as also discussed by Applicant, on specification page 2, lines 3-20). However, the prior art of record art does not reasonably teach or suggest Applicant's unexpected result of producing self-assembling microcapsules comprising fine spherical particles encapsulating hydrophilic core substances (Applicant's claims 8-13, and as described in specification page 3, lines 17-24).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

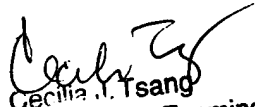
Claims 4-13 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached on M-Th. 7AM-5:30PM (10 Hrs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecelia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA, 07/21/2006


Cecelia J. Tsang
Supervisory Patent Examiner
Technology Center 1600